

Response
In re: Hays et al.
Serial No. 09/782,685
Filed: February 13, 2001

REMARKS

Applicant and Examiner Tran conducted a telephone interview on or about October 26, 2007, during which Examiner Tran indicated that the resubmission of the July 12, 2007 Declaration with the signature of inventor Roy Hays would be considered to raise new issues after final rejection, and would not be entered absent the filing of a request for continued examination (RCE). Per the Examiner's requirement, Applicant has submitted herewith the Declaration with Mr. Hays' signature, together with a RCE. Under the circumstances, Applicant respectfully submits that in the event that the Examiner issues another Action, the Action should be non-final.

Claims 1-13 remain pending.

Claims 1 and 3-13 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,336,136 to Harris. Claim 2 has been rejected under 35 U.S.C. 103(b) as being rendered unpatentable by Harris in view of U.S. Patent No. 5,826,267 to McMillan. These rejections are respectfully traversed for the reasons given below and withdrawal of the same is respectfully requested.

On July 12, 2007, Applicant filed a Declaration executed by Billy W. Hensley to antedate Harris. The Examiner found the Declaration defective because it did not contain the signatures of the joint inventors. To overcome this defect, Applicant has filed herewith a substantively identical Declaration to that submitted on July 12, 2007, with Mr. Hays' signature. Applicant has now submitted the Declaration with both inventors' signatures, thereby addressing the defect.

The Examiner also indicated in a subsequent telephone interview that he would refuse entry after final of a Declaration with all signatures on the ground that the resubmission of the

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Declaration would raise new issues. While Applicant respectfully disagrees with the Examiner's position, to expedite prosecution Applicant has acquiesced to the Examiner's requirement by submitting a RCE herewith.

The Examiner also objected to the Declaration as "insufficient to establish diligence from a date prior to the date of reduction to practice of the Harris reference to either a constructive reduction to practice or an actual reduction to practice. Applicant has established that conception occurred prior to the filing date of the Harris reference on 12/24/1999. Applicant must then establish diligence from 12/24/1999 until the filing of Applicant's patent application on 9/1/2000. *Applicant has failed to establish diligence from 12/24/1999 through 2/29/2000.* Thus, the affidavit is insufficient to overcome the Harris reference." (Final Office Action, page 2, emphasis added)

Assuming that Applicant is not able to establish a reduction to practice date prior to 12/24/1999 and therefore must rely on due diligence, Applicant respectfully disagrees with the Examiner's conclusion that diligence has not been established from 12/24/1999 through 2/29/2000.

The submitted Declarations establish that in early 2000 the server containing the computer program code of the invention crashed. All archived "checked-in" files were lost as a result of the crash. (7/12/07 Declaration, ¶ 10) Applicant expended extensive efforts to repair the server and recover data saved on the server. (7/12/07 Declaration, ¶ 10) When these efforts proved unsuccessful, the server was replaced. These efforts concluded in late February of 2000. (7/12/07 Declaration, ¶ 10) All archived server records of the software code checked in during and prior to the December 24, 1999 through February 29, 2000 period

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were permanently and irrevocably lost because of the server crash. (7/12/07 Declaration, ¶ 10)

The unintentional loss of data during the period of 12/24/1999 to 2/29/2000 and the diligent efforts of Applicant to attempt to retrieve the data and ultimately rebuild the server are not even mentioned by the Examiner in the final Office Action. Based on the Examiner's lack of comment on the issue, presumably the Examiner dismissed these efforts as irrelevant.

The period during which diligence is required may be accounted for by either affirmative acts “*or acceptable excuses.*” MPEP 2138.06 (emphasis added). *See also Griffith v. Kanamaru*, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987); *Rebstock v. Flouret*, 191 USPT 342, 345 (Bd. Pat. Inter. 1975). In *Griffith*, the Federal Circuit considered the following instances as examples of excusable periods of inactivity:

- Delay completing a patent application until after returning from a three week vacation in Sweden, extended by illness of inventor’s father. *Reed v. Tornqvist*, 436 F.2d 501 (CCPA 1971).
- Delay in filing excused because of confusion relating to war. *Texas Co. v. Globe Oil & Refining Co.*, 112 F.Supp. 455, 98 USPQ 312 (N.D. Ill. 1953).
- Delay excused where applicant made *bona fide* attempts to perfect his invention, applicant’s poor health, responsibility to feed his family, and daily job demands. *De Wallace v. Scott*, 15 App.D.C. 157 (1899).

In each of these instances, the excuse did not relate directly to development of the invention, but to how exigent circumstances in the inventor’s personal life resulted in an excused period of delay. In some instances, the cases related to an illness or vacation taken by the inventor. *Hybritech, Inc. v. Abbott Labs.*, 4 USPQ2d 1001, 1006 (C.D. Cal.

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1987) ("People may be sick or even take vacations (thereby creating gaps in activity) while still being diligent.")

The argument for finding an "excuse" is even more compelling here. Here, rebuilding of the server related directly to the practice and testing of the invention. Work that relates directly to the invention may be relied upon to show reasonable diligence. *Naber v. Cricchi*, 567 F.2d 382, 384, 196 USPQ 294, 296 (CCPA 1997), *cert. denied*, 439 U.S. 826 (1986). Particularly on point is *Scott v. Koyama*, 281 F.3d 1232, 1248-40, 61 USPQ2d 1856, 1859 (Fed. Cir. 2002). In *Scott*, the Federal Circuit held that activities directed towards building a plant to practice the claimed process of producing tetrafluoroethane on a large scale constituted efforts toward reduction to practice, and thus were evidence of diligence. The Federal Circuit was willing to accept as a reasonable excuse the time period required for the applicant to build a large scale production plant. Similarly, here Applicant was required to rebuild its computer server to practice and continue development of the invention. The applicant in *Scott* presumably would have required a much longer time period to build a large scale production plant than Applicant required to rebuild the hardware necessary to carry out the invention.

Other decisions finding acceptable delay for testing purposes include *In re Jolley*, 308 F.3d 1317, 1326-27, 64 USPQ2d 1901, 1908-09 (Fed. Cir. 2002) (diligence found based on research and procurement activities) and *Keizer v. Bradley*, 270 F.2d 396, 123 USPQ 215 (1959) (delay excused where inventor, after producing a component for a color television, delayed filing to produce an appropriate receiver for testing the component).

An inventor does not have to take the most expeditious course to the actual reduction to practice, so long as the party's efforts are reasonably diligent under the circumstances.

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Stamicarbon Bv v. Sepracor, Inc., 2001 U.S. Dist. LEXIS 9061. *See also De Solms v. Schoenwald*, 15 USPQ2d 1507, 1511 (Bd. Pat. App. & Int'l 1990). Evidence of constant effort is not required to establish reasonable diligence. *Wiesner v. Weigert*, 666 F.2d 582, 588 (Bd. Pat. App. & Int'l 1981); *see also Hybritech*, 4 USPQ2d at 1006 (holding that an inventor had exercised reasonable diligence even though the inventor's log book showed some days of inactivity). Thus, the question is whether the inventors pursued their goal in a reasonable fashion. *Hybritech*, 4 USPQ2d at 1006. In other words, "if they were doing the things reasonably necessary to reduce the idea to practice, then they were diligent *even if they did not actually work on the invention each day.*" *Id.* (emphasis added)

Applicant's efforts in repairing and eventually rebuilding servers needed for developing and running computer software embodying the invention were reasonably necessary, related directly to the reduction to practice of the invention, and was reasonable under the circumstances.

For these reasons, Applicant has established due diligence, and Harris is effectively removed as prior art under 102(e).

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In view of the foregoing remarks, the present application is now believed to be in condition for allowance. The Examiner is asked to consider this response and pass the application to allowance. Should the Examiner have any questions, he is requested to contact the undersigned.

Respectfully submitted,



David S. Taylor
Registration No. 39,045

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BERENATO, WHITE & STAVISH, LLC
6550 Rock Spring Drive, Suite 240
Bethesda, MD 20817
Telephone: (301) 896-0600
Facsimile: (301) 896-0607